

## **REMARKS**

The present Amendment is in response to the Examiner's Office Action mailed December 1, 2006. By this paper, no claims are amended, added, or cancelled. Claims 1-30 are now pending in view of the above amendments.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicants request that the Examiner carefully review any references discussed below to ensure that Applicants understanding and discussion of the references, if any, is consistent with the Examiner's understanding.

### **I. Rejection Under 35 U.S.C. § 103**

The Examiner rejects claims 1-3, 7-13, 15, 18-20, and 24-30 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,666,450 to Fujimura et al. ("Fujimura") in view of United States Statutory Invention Registration No. H315 to Genco et al. ("Genco"). As an initial matter, Applicants note that in order to establish a *prima facie* case of obviousness, it is the burden of the Examiner to demonstrate that three criteria are met: first, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; second, there must be a reasonable expectation of success; and third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *MPEP* § 214.

"The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." *MPEP* 706. Moreover, "[i]n rejecting

claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, **the particular part relied on must be designated as nearly as practicable.** The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR 1.104 (emphasis added).

According to the Examiner, Fujimura teaches “a chuck configured to support said optical assembly, said chuck being adapted to support said optical assembly without obstructing a view of at least a portion of said lens” (emphasis added), but the Examiner has failed to point out where the chuck is shown or described by Fujimura. Rather, the Examiner makes a vague reference to Figures 1-2 and Figures 15-18. The Applicants have reviewed these portions of Fujimura and are unable to identify a chuck. There simply does not appear to be a chuck as recited in the pending claims and pending specification.

Genco does not teach or suggest a chuck as recited in the pending claims and is not cited by the Examiner as teaching such. Therefore, the Examiner has failed to set forth a *prima facie* case of obviousness as the Examiner has not shown that the purported combination of Fujimura and Genco teach or suggest all the claim elements. Applicant respectfully requests that the rejection of claims 1-3, 7-13, 15, 18-20, and 24-30 be withdrawn.

Applicants respectfully note that 37 CFR 1.104 requires the Examiner to designate the portions of the prior art relied upon for a rejection. Accordingly, if the Examiner chooses to maintain that Fujimura teaches a chuck as recited in the pending claims, Applicants request that the Examiner specifically point to the portions of Fujimura that teach this element.

Further, the Examiner admits that Fujimura does not teach a visual display system, but instead relies on Genco to show this element and then purports that it would have been obvious to for one of skill in the art to use the purported visual display system of Genco with the alignment system of Fujimura. Applicant notes that the question of motivation to combine the two references is whether one of skill in the art, after having read Fujimura, would be motivated to add the purported display system of Genco to Fujimura. Applicant points to column 8, lines 55-65 that are cited by the Examiner. This portion appears to teach away from the need for a visual display as the cited portion states “it would be **impossible** to carry out the axis-alignment in the XYZ directions by moving the heavy camera that is fixed to the same supporting stand as the fiber.” (emphasis added). As Fujimura is concerned with aligning an optical fiber with a

photonic device, one of skill in the art would not be motivated to add a visual display system after reading Fujimura as Fujimura explicitly states that use of a camera, which is integral to a visual display system, would make the whole alignment process of Fujimura impossible.

In addition, assuming arguendo that there is proper motivation to combine Fujimura and Genco, the Examiner has still not shown that the purported display system of Genco teaches “a visual display system adapted to depict a position of said lens relative to said photonic device and to measure said position” (emphasis added). The Examiner simply states on page 3 of the Office Action that “The reference of Genco teaches of a visual display system” and then cites Figure 1 and column 2, lines 48-61 of Genco. However, the cited portions of Genco do not teach or suggest that the purported display system of Genco is “adapted to depict a position of said lens relative to said photonic device and to measure said position” (emphasis added) as recited in the pending claims.

Therefore, the Examiner has failed to set forth a *prima facie* case of obviousness as the Examiner has not shown that there is a proper motivation to combine Fujimura and Genco or that Fujimura and Genco teach and suggest all of the elements of the pending claims. Applicant respectfully requests that the rejection of claims 1-3, 7-13, 15, 18-20, and 24-30 be withdrawn.

Moreover, the Examiner has not shown that the camera in Fujimura actually depicts a position of the lens relative to a photonic device. Figures 1 and 2 of Fujimura relate to alignment of a semiconductor laser 16 with an optical fiber 9. In direct contrast, claim 1 requires “a visual display system adapted to depict a position of said lens relative to said photonic device....” Fujimura’s system of Figure 1 is simply an active configuration (like that discussed in the “Background” section of the present application) that measures the power received by the optical fiber from the semiconductor laser to determine optical alignment. No depiction of relative positions of a lens and photonic device is taught by Figures 1, 2, discussed in column 8, lines 55-65, or would be required by the teachings of Fujimura. Rather, these portions of Fujimura relate to active alignment of a fiber with a laser using the output of the laser, and not a visual depiction of their position, for alignment. Genco does not teach this element and is not cited by Examiner as teaching such.

The Examiner has also not shown that Fujimura teaches measurement of such position. Fujimura essentially “searches” for the focal point of a light transmission from the semiconductor laser by moving in various patterns. *See* Figure 5 and column 4, lines 31-63; col.

6, lines 22-53. Because Fujimura does not determine relative positions of a lens and a photonic device Fujimura also does not measure such position. Moreover, because Fujimura merely searches for a focal point of as shown in Figure 5, Fujimura does not conduct quire measurement of a position. Genco does not teach this element and is not cited by Examiner as teaching such.

The Examiner also has not shown that a position of a lens relative to a photonic device is depicted by Fujimura. Referring to Figure 2, and its related disclosure, it is clear that Fujimura relates to alignment of a first optical device (including the semiconductor laser chip (1), the photodiode (2), and the spherical lens (6)) with the optical fiber (9). Col. 2, lines 29-32. In Figures 1 and 2 of Fujimura, “axis of the semiconductor laser chip (1), the photodiode (2) and the spherical lens (6) [have] already been aligned at the time of producing the device.” Therefore, the position of the lens (6) and semiconductor laser chip (1) need not be aligned by the invention of Fujimura. Genco does not teach this element and is not cited by Examiner as teaching such.

For at least these reasons the Examiner has not set forth a proper *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejection of claims 1-3, 7-13, 15, 18-20, and 24-30 28 under 35 U.S.C. § 103(a) be withdrawn.

The Examiner rejects claims 4, 14, and 21 under 35 U.S.C. § 103 as being unpatentable over Fujimura in view of Genco and further in view of the Examiner’s Official Notice.

Claim 4 depends from claim 1, claim 14 depends from claim 12, and claim 21 depends from claim 18. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, claims 4, 14, and 21 are allowable at least for the same reason as the claim(s) from which they depend.

Regarding the Examiner’s Official Notice, the Applicant does not argue that a zoom lens is not well known. However, the issue under section 103 is not whether each single element of a claim is known, but rather, whether the combination of the elements is known or obvious. It is well established that the mere fact that something is “well-known” cannot serve as a substitute for motivation. *See In re Sponnoble*, 160 USPQ 237, 243 (CCPA 1969) (emphasis added) (“a patentable invention, within the ambit of 35 U.S.C. §103, may result even if the invention has, in effect, merely combined features, old in the art, for their known purpose, without producing anything beyond the results inherent in their use.”); *also see In re Warner*, 154 USPQ 173, 177

(CCPA 1967) which establishes that the question is never simply what is old; rather, the question is the obviousness of bringing the elements claimed in combination together. Accordingly, merely asserting that particular features of the claims are “old” or “well-known” in the art does nothing to establish a reason why one of ordinary skill in the art would have been led to combine such features and, thus, does not inherently establish obviousness. Therefore, while the Official Notice may establish that a zoom lens exists, it does nothing to establish the obviousness of the combination of elements set forth in claims 4, 14, and 21. As such a *prima facie* case of obviousness has not been set forth and the rejections should be withdrawn.

The Examiner rejects claims 5-6, 16-17, and 22-23 under 35 U.S.C. § 103 as being unpatentable over Fujimura in view of Genco and further in view of United States Patent No. 5,621,831 to Staver et al.

Claims 5-6 depend from claim 1, claims 16-17 depend from claim 12, and claims 22-23 depends from claim 18. If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988). Therefore, claims 5-6, 16-17, and 22-23 are allowable at least for the same reason as the claim(s) from which they depend.

**CONCLUSION**

In view of the foregoing, Applicants believe the claims as amended or presently pending are in allowable form and that every issue raised by the Office Action has been addressed. In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, or which may be overcome by an Examiner's Amendment, the Examiner is requested to contact the undersigned attorneys.

Dated this 1st day of May, 2007.

Respectfully submitted,



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